

In the claims:

Please cancel claims 23-26.

REMARKS

Upon entry of the proposed amendment, claims 20-22 and 27-32 will be pending. In response to the restriction requirement, please cancel claims 23-26 without prejudice.

Claims 20-22 and 27-32 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 14-19 of U.S. Pat. No. 5,540,908 to Koch *et al.* Significantly, however, the Office Action fails to provide evidence tending to establish that one skilled in the art would have been motivated to substitute the group $-\text{CH}_2-\text{CX}_2-\text{CHX}_2$, wherein X is hydrogen or a halogen, for $-\text{CHX}-\text{CX}_2-\text{CF}_3$. Absent such evidence, a *prima facie* case of obviousness is lacking.

As best understood by Applicants, the Office Action suggests that the structural similarity of the compounds presently claimed to compounds of the '908 patent renders the present compounds obvious. However, it is settled law that when the prior art fails to teach or suggest a method for making a claimed compound at the time the invention was made, the compounds themselves cannot be rendered obvious. *In re Hoeksema*, 158 USPQ 597, 601 (CCPA 1968). Significantly, prior to the present invention, there were no known or obvious methods for

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producing the compounds presently claimed, which signifies that the compounds would not have been obvious to one skilled in the art at the time of the invention.¹

Applicants believe that the present claims are in condition for allowance. An early Office Action to that effect is, therefore, earnestly solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,


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Date:

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¹Applicants direct the Examiner's attention to the specification, at page 14, line 11 to page 15, line 1, which describes the novel methods for preparing the presently compounds.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Claims 23-26 have been canceled.